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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,826	12/24/2003	Yoshinobu Kitajima	26170-168120	1145
38598	7590	10/16/2006	EXAMINER	
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			MARX, IRENE	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,826	<b>Applicant(s)</b> KITAJIMA ET AL.	
	<b>Examiner</b> Irene Marx	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The application should be reviewed for errors.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

Claims 15-17 are being examined on the merits.

Claim 17 was inadvertently omitted from the restriction requirement. The error is regretted.

Claims 1-14 and 18-27 are withdrawn from consideration as directed to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is confusing in the recitation “agent consistent to claim 15 comprised of”. This is not standard dependency language, and it is unclear what is intended to be encompassed. Amendment to “according to claim 15”, for example, would be remedial.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yeung *et al.*.

The claims are directed to a composition containing *Pleurotus nebrodensis* as a main ingredient, which may be a dried powder or hot water extract, which has disease preventing/treating properties.

Yeung *et al.* disclose a composition of *Pleurotus nebrodensis* having hypolipidemic effects.. See, e.g., Abstract.

Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen *et al.* ((2000) Collection of Mushroom Prescriptions; Shanghai Science and Technology/Press, Shanghai, China, pp. 430-431)

The claims are directed to a composition containing *Pleurotus nebrodensis* as a main ingredient, which may be a dried powder or hot water extract, which has disease preventing/treating properties.

Chen *et al.* disclose that various medicinal compositions of *Pleurotus nebrodensis* having various medicinal effects are known in the art. See, e.g., Translation.

Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Agrifffchina (<http://www.agrifffchina.com/e-agrifffchina/product/detail.jsp?id=2637>)

The claims are directed to a composition containing *Pleurotus nebrodensis* as a main ingredient, which may a dried powder or hot water extract, which has disease preventing/treating properties.

Agrifffchina disclose that various medicinal compositions of *Pleurotus nebrodensis* having various medicinal effects are known in the art. See, e.g., Commodity Specification.

Claims 15-17 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wang *et al.*.

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The claims are directed to a composition containing *Pleurotus nebrodensis* as a main ingredient, which may be a dried powder or hot water extract, which has disease preventing/treating properties.

The cited reference discloses a composition containing *Pleurotus nebrodensis* which appears to be identical to the presently claimed composition (see, e.g., col. 2) since it was obtained from *Pleurotus eryngii* (DC et Fr.) Quel or *Pleurotus eryngii* (DC et Fr.) Quel *nebrodensis* which each produces biological active products and which appear to be the same. The referenced composition appears to be identical to the presently claimed composition and is considered to anticipate the claimed composition since comprises a fungus of the same class as that of the composition claimed and is taught to be effective against various conditions. Consequently, the claimed composition appears to be anticipated by the reference.

In the alternative, even if the claimed composition is not identical to the referenced composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced composition is likely to inherently possess the same characteristics of the claimed composition particularly in view of the similar characteristics which they have been shown to share and the clearly close relatedness between the fungi belonging the same species.. Thus the claimed composition would have been obvious to those skilled in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Irene Marx

Primary Examiner

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